

REMARKS

The Examiner's thoughtful consideration and Advisory Action are appreciated by the Applicants. Claims 1-28 were originally filed in the present application. Claims 1-7 were subsequently canceled without prejudice or disclaimer, and new claims 29-35 were added. Claim 30 was subsequently canceled without prejudice or disclaimer.

Independent claims 14 and 22, along with all their dependent claims are currently canceled. Dependent claims 36-39 are currently added. Thus, claims 8-13, 29, and 31-39 are currently pending in the present application.

Examiner Interview Summary

On March 9, 2007, a telephone interview was conducted between Examiner Peaches and Craig Bohn, Attorney for Applicants. A draft of this response with the claims as above was shown. The appropriateness of the amendments, deletions, and additions were discussed. An agreement was reached that the amendments are appropriate for admission and consideration after-final by the Examiner. Additionally, the scope of the independent claims, the removal of the superfluous first step in claim 29, and the added claims were discussed. The Examiner communicated that the amendments addressed his concerns over non-obviousness, but inquired into the antecedent basis for the subject matter of the new claims. This response represents changes made to the remarks of the draft response, and addresses the antecedent basis of the subject matter of the new claims in Section C, below. The claims presented are the same as presented in the draft response. The Examiner requested official submission of the response, so he could provide an official response. Consequently, it is believed that the claims are currently in condition for allowance.

Comments Regarding Amendments to the Claims.

A. The current amendments are appropriate for consideration After-Final.

The amendments either cancel rejected claims or merely improve the form of the claims. As such the amendments are appropriate for admission and consideration after-final by the Examiner. *See* MPEP § 714.12 (citing 37 CFR 1.116(b)(1) and (2)).

B. Claims are currently amended, canceled, and added.

Independent claims 8 and 29 are amended to more precisely claim the current method and device wherein a station notifies a non-emergency capability requestor that future requests for position information will similarly be denied.

Claim 8 is amended to clarify that the capability request response is the element that includes the status indicator. The clarification merely changes an indirect reference of “that” to a direct reference. The conjunction “and” is added to maintain proper grammar.

Claim 29 is amended to eliminate the non-distinguishing step of “transmitting a non-emergency-services position-determination (NESPD) message to a mobile station.”

Claims 14-28 are currently canceled, without prejudice or disclaimer.

The newly added claims 36-39 are two (2) dependent claims to each of independent claims 8 and 29, and specifically claim examples for including the status indicator.

C. The original disclosure provides antecedent basis for all the amendments and additions.

The amendments do not constitute new matter. The original disclosure teaches in paragraph [0027] that the status indicator (120) can occupy one bit, which is shown in Figure 1 to be in the same octet as the reserved bits (130), as claimed in new claims 37 and 39. The original disclosure further teaches in paragraph [0027] and Figure 1 that there may be seven (7) reserve bits (130), and the last sentence of paragraph [0027] teaches that one or more of the reserved bits (130) could be used for the status indicator (120). Using all the reserve bits (130) in the

exemplary embodiment shown in Figure 1 would result in the status indicator (120) occupying eight (8) bits, as claimed in new claims 36 and 38. The disclosure does not limit the number of reserve bits (130), so the disclosure similarly does not limit the number of bits the status indicator (120) may comprise.

Comments Regarding Rejections Under 35 U.S.C. §103

Claims 8-13, 29, and 31-35 were rejected under 35 U.S.C. §103 as being unpatentable over Havinis, et al. (US Pat. No. 6,311,069, hereinafter referred to as “Havinis”) in view of Zellner, et al. (US Pat. No. 6,675,017, hereinafter referred to as “Zellner”). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to the currently amended independent claims 8 and 29.

To establish a *prima facie* case of obviousness, [1] there must be some suggestion or motivation to modify the reference or combine the reference teachings; [2] there must be some reasonable expectation of success; and [3] the prior art must teach or suggest all the claim limitations. MPEP § 706.02(j). All three conditions are required for each claim to be considered *prima facie* obvious. It is submitted that in the present case the Examiner has not factually supported a *prima facie* case of obviousness, because the combination of Havinis and Zellner do not teach or suggest all the claim limitations of any of the present claims.

The references do not teach or suggest all the claim limitations.

An example of a claim limitation that the combination of Havinis and Zellner neither teaches nor suggests is that each current claim includes a status indicator. The status indicator “inform[s] the non-emergency services provider that non-emergency position-determining capabilities of the mobile device have been disabled.” Paragraph [0018]. Upon receiving this notice, the requestor can know the station’s future intent to not provide position information.

The combination of Havinis and Zellner does not teach or suggest informing the requestor of the status of the system, which leaves the requestor to presume the request failed due to

transmission failure, in either the request or the response. The combination only addresses a current request, which upon failure will result in additional futile requests being made by the requestor. Both independent claims 8 and 29 include providing the requestor with a **status indicator**, from which the requestor can understand that any future requests will similarly fail.

Zellner teaches a profile that permits elimination of redundant failed communication *internal* to the system, since the mobile station can instruct the base station to not provide location information, and the base station can act upon future requests with that instruction. But Zellner does not teach informing the requestor of future intent to not respond, as in the status indicator, so the requestor might choose to cease sending requests and thereby eliminate redundant failed communication *external* to the system. *See Zellner*, column 2, line 65, to column 3, line 13. Zellner can not be seen to suggest or teach a status indicator that informs a requestor of future system intent, as currently claimed.

In Havinis, as described at column 6, line 23 to 27, the requestor receives a default response (17) from the system after a timer (19) expires prior to receiving a response from the mobile station (20). This process does not inform the requestor of the system's status that will result in future non-responses. The requestor will most-likely continue to send requests, not knowing the system status will not permit a response. Havinis can not be seen to suggest or teach a status indicator that informs a requestor of future system intent, as currently claimed.

Since neither Havinis nor Zellner teach or suggest the teaching of the current disclosure, contained in the current claims, the combination of Havinis and Zellner can not appropriately form the basis for a *prima facie* case of obviousness.

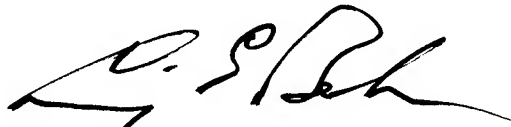
CONCLUSION

The foregoing shows that independent claims 8 and 29 are in condition for allowance. Dependent claims 9-13 and 31-39 depend from and further limit independent claims 8 and 29 and, therefore, are allowable as well.

It is believed that all matters set forth in the Office Action have been addressed, and that claims 8-13, 29, and 31-39 are in condition for allowance. Favorable consideration and an early

indication of the allowability of the claims are respectfully requested. Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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